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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,598	06/29/2000	Jay S. Walker	00-023	1725

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EXAMINER

THEIN, MARIA TERESA T

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 03/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/609,598

Applicant(s)

WALKER ET AL.

Examiner

Marissa Thein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

Examiner rejected claims 1-66 in a First Office Action of September 25, 2002. Claims 1-66 are pending; they will be considered for examination.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-66 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claim 1, 3-58, 60-66 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,285,986 to Andrews.**

Regarding claims 1, 55, 58, 60, 65-66, Andrews discloses a method, system, and medium storing instructions of facilitating a transaction (col. 3, lines 1-3) comprising: receiving an indication of a plurality of product categories, each product category being associated with a plurality of products (col. 2, lines 59-65); receiving buyer offer information, including an indication of an offer amount associated with the plurality of product categories (col. 8, lines 45-52); selecting a

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subset of the plurality of products for each of the product categories (col. 4, lines 1-22; col. 5, lines 20-23; col. 9, lines 36-49); and providing an indication of the selected products (col. 4, lines 1-22; col. 5, lines 20-23).

Regarding claims 3-4, Andrews discloses receiving indication of the plurality of product indication of product categories via at least one of: a communication network, the Internet, a Web site, a telephone network, a wireless network, and a proprietary network; receiving the indication from at least one of: a buyer device, personal computer, a personal digital assistant, a telephone, a controller, a merchant device, a kiosk, an interactive voice response unit, an operator, a point of sale terminal; and an automated teller machine device (col. 5, line 64 – col. 6, line 59).

Regarding claims 5-9, Andrews discloses a product category and a product brand associated with the product description (col. 2, lines 15-20; col. 8, lines 13-14); an indication of a plurality of acceptable products; the indication of the plurality of products is received from a database; the indication of the plurality of products and the buyer offer information are received with respect to a single transaction; and receiving the buyer offer information from a buyer. (See at least col. 8, lines 8-64)

Regarding claims 10-11, Andrews discloses receiving the buyer offer information via at least one of: a communication network, the Internet, a Web site, a telephone network, a wireless network, and a proprietary network; and receiving the buyer offer information from at least one of: a buyer device, personal computer, a personal digital assistant, a telephone, a controller, a

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merchant device, a kiosk, an interactive voice response unit, an operator, a point of sale terminal, and an automated teller machine device (col. 5, line 64 – col. 6, line 59).

Regarding claims 12-16, Andrews discloses a binding offer; a buyer-defined offer; a plurality of product category offer amounts; a selection from a list of suggested offer amounts (see at least col. 8, lines 36-64).

Regarding claims 17-18, Andrews discloses selecting at least one of the selected products based on: a transaction history, address, demographic information, psychographic information, a credit rating, and another offer (col. 5, line 64 – col. 6, line 15; col. 11, lines 4-18); and selecting at least one of the selected products based on the offer amount (col. 8, lines 36-44).

Regarding claims 19-27, Andrews discloses selecting at least one of the selected products based on subsidy; subsidy is associated with at least one of the selected product; the subsidy is associated with at least one product that was not selected; the subsidy is associated with a manufacturer of at least one of the selected products; the manufacturer provides payment of a subsidy amount on a product-by-product basis; the manufacturer provides payment of a subsidy amount based on at least one of: a predetermined number of products being sold, predetermined percentage of products being sold, and a combination of products being sold; wherein the subsidy is associated with at least one: a buyer, a controller, and a merchant; disclose wherein the subsidy is associated with at least one of: a product identifier, a product category, a product manufacturer, a product brand, a product description, a product quantity, a product class, at least

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one product feature, an accessory associated with the product, a product condition, a product preference, an offer period, a product cost, a product retail price, the offer amount, delivery information, and payment information; and tracking subsidies applied to a transaction. (See at least col. 5, lines 51-63; col. 9, lines 34-49; col. 13, lines 3-42; col. 13, line 64-col. 14, line 14)

Regarding to claims 28-33, Andrews discloses providing the indication of the selected products to the buyer; providing the indication of the selected products to a merchant, providing the indication of the selected products via at least one of: a communication network, the Internet, a Web site, a telephone network, a wireless network, and proprietary network; receiving the indication of the plurality of products and the receiving the buyer offer information are performed via a first communication, and the providing the indication of selected product is performed via second communication network; providing the indication of the selected products to at least one of: a buyer device, a personal computer, a personal digital assistant, a telephone, a controller, a merchant device, a kiosk, an interactive voice response unit, an operator, a point of sale terminal, and an automated teller machine device. (See at least abstract, col. 5, line 64 - col. 59, lines col. 8, lines 8-66)

Regarding claims 34-39, Andrews discloses evaluating the buyer offer information based on the offer amount; the evaluation is based on: transaction history, an address associated with the buyer, demographic information associated with the buyer, psychographic information with the buyer, a credit rating, another offer, and an indication of a plurality of merchants associated with

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the buyer; calculating a probability that an offer will be accepted on: the offer amount, at least one minimum acceptable price associated with the selected products; minimum acceptable price is based on at least of: a product cost, and a product retail price; calculating a total minimum acceptable price based on the sum of each minimum acceptable price associated with each of the selected products; and comparing the total minimum acceptable price to the offer amount. (See at least col. 8, lines 36-59; col. 11, lines 31-51)

Regarding claims 40-41, Andrews disclose applying a penalty to the buyer based on the evaluation; the penalty comprises: arrange for a buyer to provide a penalty amount, and preventing at least one subsequent offer from the buyer (col. 10, lines 53-65).

Regarding claims 42-46, Andrews discloses evaluating is based on a subsidy; determining the subsidy based on the plurality of product categories; selecting the subsidy from a plurality of potential subsidies; the subsidy is based on information associated with a buyer; and the subsidy is based on information associated with at least: a product identifier, a product category, a product manufacturer, a product brand, a product description, a product quantity, a product class, at least one product feature, an accessory associated with the product, an age associated with the product, a product condition, a product preference, an offer period, a product cost, a product retail price, the offer amount, delivery information, and payment information. (See at least col. 5, lines 51-63; col. 9, lines 34-49; col. 13, lines 3-42; col. 13, line 64-col. 14, line 14)

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Regarding claims 47-48, Andrews discloses the evaluating comprising determining that the buyer offer information is not acceptable; providing a suggested modification to the buyer offer information; and the suggest modification comprises: modified offer amount, a modified plurality of product categories, and a modified plurality of products associated with at least one product category. (See at least col. 8, lines 36-64)

Regarding claims 49-54, Andrews discloses arranging for a buyer to provided payment of an amount based on the offer amount; arranging to receive payment from the buyer; arranging to provide payment to a merchant; arranging for the buyer to provide payment to a merchant; transmitting information enabling a buyer to take possession of the selected products at a merchant; and arranging for the selected products to be delivered. (See col. 8, lines 25-28; col. 13, lines 43-49)

Regarding claims 56-57, Andrews discloses the apparatus comprising a communication device coupled to the processor and adapted to communicate with at least one of: a buyer device, merchant device, a subsidy provider device, and a payment processing device; and storage device. (See at least col. 5, line 64-col.7, line 31)

Regarding 61-64, Andrews discloses a penalty to the buyer based on the evaluation; the penalty comprises: arranging for a buyer to provide payment of a penalty amount, and preventing at least one subsequent offer from the buyer; evaluating comprising: determining the buyer offer information is not acceptable, and providing a suggested modification; and the suggested modification



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comprises at least one of: a modified offer amount, a modified plurality of product categories, and a modified plurality of products associated with at least a product category. (See at least summary, col. 8, lines 8-64,)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 2 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andrews in view of PCT Publication WO/9834187 to Grofthehaug et al.**

Regarding to claim 2, Andrews disclose substantially the claimed invention, however, it does not disclose receiving the indication of the plurality of product categories from a buyer. Grofthehaug, on the other hand, teaches receiving the indication from a buyer (see page 3, lines 23- page 4, line 2; page 10, lines 9-14). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Andrews to include receiving the indication from a buyer, as taught by Grofthehaug, so as to provide a prioritized list of choices which a buyer may possibly desire to buy (Abstract).

Regarding to claims 59, Andrews discloses a computer-implemented method of facilitating the sales products comprising: a payment identifier; a

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product first product category; a second category; receiving from the buyer a binding buyer offer; selecting a first product; selecting a second product, wherein the first product and second product are selected based on an associated subsidy; evaluating the buyer offer; arranging for the buyer to provide payment; providing to the buyer an indication of the first product and the second product; and transmitting information enabling the buyer to take possession of the first products and the second product at a merchant. (See at least col. 8, lines 8-67; col. 13, lines 3-42) Andrews does not disclose receiving the indication of the plurality of product categories from a buyer. Grofthehaug, on the other hand, teaches receiving the indication from a buyer (see page 3, lines 23- page 4, line 2; page 10, lines 9-14). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Andrews to include receiving the indication from a buyer, as taught by Grofthehaug, so as to provide a prioritized list of choices which a buyer may possibly desire to buy (Abstract).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on Monday-Friday 8:30-5:30.

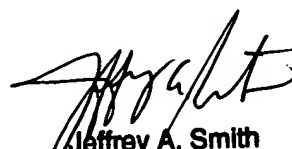
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is

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assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

mtot  
March 10, 2003



Jeffrey A. Smith  
Primary Examiner